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First named inventor: Simpson
Serial no. 10/056,687
Filed 1/24/2002
Attorney docket no. 10008198-1

REMARKS

Claim objections

Claim 8 has been objected to because the comma at the end of the second line, after the word "browser," is more properly a semi-colon. Applicant has amended claim 8 to substitute a semi-colon for the comma, and requests withdrawal of this objection.

Claim rejections under 35 USC 112

Claim 1 has been rejected under 35 USC 112, second paragraph, as being indefinite. First, the Examiner believes that the limitation "a second server, comprising a printing apparatus with an embedded web server" is unclear. Although Applicant does not agree with the Examiner, to further the present patent application to allowance, this phrase has been amended to simply recite "a printing apparatus having an embedded web server." It should thus be clear to the Examiner that a printing apparatus can have an embedded web server, and as such Applicant requests the withdrawal of this rejection.

Second, the Examiner has stated that the limitation "a different at least one generic instruction" has insufficient antecedent basis, and notes that claim 1 does previously recite "a generic access instruction," but not "at least one access instruction." Applicant has amended claim 1 so that the recitation of "a generic access instruction" now reads "one or more generic access instructions" and the recitation of "a different at least one generic instruction" now reads "a different one of the generic access instructions." Therefore, the latter limitation has antecedent basis to the former limitation, and Applicant requests the withdrawal of this rejection.

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Claim rejections under 35 USC 103

Claims 1-35 have been rejected under 35 USC 103(a) as being unpatentable over Grasso (2002/0116291) in view of Ferlitsch (2002/0113989). Claims 1, 8, 19, and 26 are independent claims, from which the remaining claims rejected on this basis ultimately depend. Applicant submits that claims 1, 8, 19, and 26 are patentable over Grasso in view of Ferlitsch, such that all the pending claims are patentable over Grasso in view of Ferlitsch.

Claim 1 is discussed as representative of all the independent claims 1, 8, 19, and 26, insofar as patentability over Grasso in view of Ferlitsch. Claim 1 is limited to a printing apparatus that has an embedded web server. All of the other independent claims are similarly limited.

However, Grasso in view of Ferlitsch does not teach, disclose, or suggest a printing apparatus, such as a printer, having an embedded web server. The Examiner in particular admits that Grasso does not teach, disclose, or suggest a printing apparatus having an embedded web server, but states that Ferlitsch does, such that the combination of Grasso in view of Ferlitsch discloses a printing apparatus embedded web server. In particular, the Examiner has relied upon paragraphs [0032], [0035], [0051], and [0063]-[0065] of Ferlitsch as teaching this limitation of the claimed invention.

However, Applicant has reviewed Ferlitsch in detail, and cannot find any reference therein to Ferlitsch teaching, disclosing, or suggesting a printing apparatus with an embedded web server. Applicant has reviewed both the paragraphs of Ferlitsch relied upon by the Examiner, as well as all the other paragraphs of Ferlitsch. The terminology "web" indeed does not appear in Ferlitsch at all, let alone a printing apparatus that has an embedded web server. Insofar as Ferlitsch does not disclose this aspect of the claimed invention, Grasso in view of Ferlitsch does not disclose this aspect of the claimed invention.¹

¹ Applicant is very much cognizant of the fact that the rejection has been proffered by the Examiner under 35 USC 103(a) over Grasso in view of Ferlitsch, and that attacking a single reference, like Ferlitsch, is not a proper response when a rejection is made on a number of

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As the Examiner is well aware, "to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." (MPEP sec. 2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)) Here, the prior art does not teach, suggest, or disclose a printing apparatus having an embedded web server. This limitation of the claimed invention is not a throwaway limitation, but rather is an explicit part of the claimed invention. An embedded web server is a particular "thing" as understood to those of ordinary skill within the art, and must be considered in properly interpreting the claims. In this respect, Applicant refers the Examiner to the patent application as originally filed, which goes into detail as to what an embedded web server "is." Thus, in order for the prior art, specifically Grasso in view of Ferlitsch, to render the claimed invention obvious, the Examiner must show where in the prior art, and specifically where in Grasso and/or Ferlitsch, a printing apparatus having an embedded web server is disclosed.

However, because Ferlitsch in particular does not teach, disclose, or suggest a printing apparatus having an embedded web server, in contradistinction to the Examiner's statements otherwise, the claimed invention is not rendered obvious nor unpatentable over Grasso in view of Ferlitsch.

references. That said, Applicant is not attacking just Ferlitsch in presenting the arguments herein. Rather, Applicant is showing how Ferlitsch does not teach the limitations of the claimed invention that the Examiner says that Ferlitsch does, such that Grasso in combination with Ferlitsch does not teach all the limitations of the claimed invention. In other words, Applicant is attacking the overall combination of Grasso in view of Ferlitsch by particularly showing how Ferlitsch does not disclose the aspects of the claimed invention that the Examiner says Ferlitsch discloses. Insofar as Ferlitsch does not disclose these aspects of the claimed invention, then the obviousness rejection made by the Examiner and that relies upon Ferlitsch disclosing these aspects of the claimed invention necessarily fails.

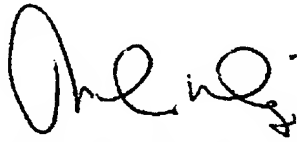
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Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

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